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APR 14 2005

Attorney Docket No. 15983/140

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re App : Gerald Matthew Rutten et al. : Examiner Samch Tawfik  
Serial No. : 10/696,713 : Art Unit 3721  
Filed : October 29, 2003 : Confirmation No. 6465  
For : Apparatus and Methods for Producing Shrink Wrap Packaging

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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ALEXANDRIA, VA 22313-1450, ON APRIL 14, 2005 TO FAX NO.:  
703-872-9306 (37 CFR 1.8a)

**RESPONSE**

Dear Sir:

In response to the Office communication mailed March 14, 2005, election of method claims 1-10 is hereby made, subject to traverse.

It is realized that the second paragraph of page 2 is a form paragraph. With this in mind, it is respectfully submitted that this form paragraph has no application to the present application. Specifically, it is respectfully requested the Examiner identify what different process the apparatus could be utilized to perform. Further, it is respectfully requested that the Examiner identify how "conveying...on a vacuum table" of claim 1 and/or the recitations of claims 3-10 could be performed by hand. Further, what "first and second pairs of pinch rollers" are the Examiner referring to? Are they recited in claim 2, and if so, how is that apparatus "different"? If the restriction requirement is continued, it is respectfully requested that the Examiner explain his position so that it is possible to respond thereto.

Assuming that the process "can be practiced by hand and/or by different apparatus", the process performed by the claimed apparatus must clearly be considered and, in fact, would logically be the first to be searched for (as it is unknown whether other apparatus can be utilized

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or another process can be practiced). The Examiner has not indicated that any extra effort would be required for searching or examining both the apparatus and method claims. Especially since many apparatus features are recited in connection with the method claims and thereby link the apparatus and method claims, it is respectfully submitted that it will be necessary to evaluate patentability of the apparatus claims when examining the method claims.

Although in different subclasses, the method and apparatus claims are in the very same class. Further, it is respectfully submitted that a search for method claims will require searching in the subclass for apparatus claims so that no additional search effort would be required. It is respectfully submitted that no or minimal extra effort would be required to examine both the apparatus and method claims.

From a simple review of issued patents, claims directed to method and apparatus are often included, and the mere existence of both method and apparatus claims is not a basis for restriction.

Thus, for patent office economics and efficiencies, the restriction requirement should be withdrawn.

Favorable consideration and allowance are respectfully requested.

Respectfully submitted,

Gerald Matthew Rutten et al.

Dated: April 14, 2005.

By: 

Alan D. Kamrath (Reg. No. 28,227)  
NIKOLAI & MERSEREAU, P.A.  
900 Second Avenue South, Suite 820  
Minneapolis, MN 55402  
Tel: (612) 392-7306  
Fax: (612) 349-6556